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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/804,364

03/16/2004

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021756-002400US

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7590

10/14/2008

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EXAMINER

EVANS, KIMBERLY L

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

10/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/804,364	Applicant(s) KING ET AL.	
	Examiner KIMBERLY EVANS	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/24/08, 9/3/08, 7/21/08, 6/25/08, 6/5/08, 5/12/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendments

1. This action is in reply to the response filed on June 23, 2008.
2. Acknowledgement is made that the applicant has amended claims 1, and 3-12; and has cancelled claim 2.
3. Claims 1 and 3-12 are currently pending and have been examined.
4. The rejections of claims 1 and 3-12 have been updated to reflect the amendments.
5. The Examiner has carefully reviewed the Applicant's response and has determined that the rejection stands and is resubmitted below addressing the claims as modified by said amendments.

Information Disclosure Statement

6. The Information Disclosure Statements filed on September 24, 2008, September 3, 2008, July 21, 2008, June 25, 2008, June 5, 2008, and May 12, 2008 have been considered. An initialed copy of the Form 1449 is enclosed herewith.

Claim Rejections - 35 USC § 112- 1st Paragraph

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1 and 3-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 describes “a storage component configured to store” and is considered new matter since this was not properly identified or described in the original specification. Claim 1 also recites “simultaneously assigned” and is considered new matter since this was not properly identified or described in the original specification. Claims 1, and 4 contain “in the set of employees” which was not properly identified or described in the original specification, and is considered new matter since this was not properly identified or described in the original specification. The dependent claims do not remedy this flaw

The added material which is not supported by the original disclosure is as follows:

- i. The newly recited claim limitation in Claim 1 “...a storage component configured to store...” appears to constitute new matter.
- ii. The newly recited claim limitation in Claim 1 “...create a report identifying at least one employee 'in the set of employees' that is simultaneously assigned to business functions that are identified as incompatible as per the at least one business function incompatibility...” appears to constitute new matter.
- iii. The newly recited claim limitation in Claim 1 “...simultaneously assigned...” appears to constitute new matter.
- iv. The newly recited claim limitation in Claims 1 and 4 “...in the set of employees...” appears to constitute new matter.

- v. In particular, Applicant does not point to, nor was the Examiner able to find, any support for the newly added claim language or language to support claim 1 within the specification as originally filed. As such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 101

1. The following is a quotation of the first paragraph of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
2. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The aforementioned claim is directed toward providing information in relation to an electronic communication device via a data signal. However, under the current guidelines of 35 USC 101, computer software must be tangibly embodied on a computer readable medium, and, when executed by a computer processor, perform the steps of the software. In its broadest reasonable interpretation and in light of the specification, claim 1 as recited can be interpreted to be embodied on abstract mediums such as carrier waves and signals, and therefore not eligible for patent protection. Accordingly, claim 1 is not eligible for patent protection.
3. Claim 1 is rejected under 35 U.S.C. 101 because the claimed components “storage component configured to store....”, “processing component in communication with...”, “compatibility register including a set of business function incompatibilities, each business

function incompatibility identifying at least two business functions....” is interpreted as being software per se; software does not fall within a statutory category of patentability. The dependent claims do not remedy this flaw and are also rejected.

4. The Examiner’s 101 rejection remains due to the 101 issues as identified above.

Double Patenting

5. Claim 1 of this application conflicts with claim 1 of Application No 10/946,146, and claim 13 of Application No. 10/946,146. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.
6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).
7. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 10/946,146. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 - (a) Determining the scope and contents of the prior art.
 - (b) Ascertaining the differences between the prior art and the claims at issue.
 - (c) Resolving the level of ordinary skill in the pertinent art.
 - (d) Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, and 3-12 are rejected as being unpatentable over Wefers et al., International Publication No WO 2005/055098 A2 in view of Kahn US Patent No 7,185,192 B1 in further view of Paulus et al., US Patent No US 7,246,137 B2, in further view of Morinville US Patent No 7,185,010 B2, in further view of Homsy US Patent No US 7,373,310 B1;

11. With respect to Claim 1,

Wefers as shown discloses the following limitations:

- *a storage component configured to store:*
 - *a set of business processes describing the operations of an enterprise; each business process including one or more business functions, each business function being assigned to one or more employees in a set of employees (see at least claim 1 ; paragraph 1: "...the invention relates to systems and methods for assigning task-oriented roles to users within an organization..."; paragraph 10: "...the organization may comprise any type of entity, such as a large or publicly traded company, a business unit, an agency, a foundation....or any other type of entity..."; paragraph 12: "...the invention may be implemented through any suitable combination of hardware, software and/or firmware....Management of Internal Controls (MIC) software application...may be performed through one or more software modules..."; paragraph 13: "...a complete list of tasks that can be performed in an organization are defined....Through an MIC application or other appropriate software, roles are defined by assigning tasks and/or organization hierarchy information to each role....")*
- *at least one processing component in communication with the storage component, the at least one processing component being configured to compare at least one business function incompatibility in the compatibility registry with the business functions assigned to each employee in the set of employees; (see at least claim 8: "...the software performs*

processes for determining whether any tasks assigned to a given role has been uniquely assigned to another role..."; paragraphs 65-69)

Wefers discloses all of the limitations described above. Wefers does not disclose the following limitation, but Kahn however, as shown discloses:

- *a compatibility registry including a set of business function incompatibilities, each business function incompatibility identifying at least two business functions that should not be simultaneously assigned to a single employee* (see at least paragraph 15: "...A user may be acting in a role (e.g., as a payroll database administrator) on a computer system that conflicts with the access control permissions of other roles that the same, or a different user, is able to act in (e.g., as an employee). As a simple example, as an employee, a user should not be able to access payroll data in certain manners (e.g., read or modify) for security reasons, but as an administrator of the payroll database, the user's job may be to maintain (e.g., backup, copy, establish a mirror copy, etc., but not specifically change or even read) data within the payroll database, including data related to that or another users salary, bonus, and the like. It should be clear that a conflict of interest arises in this situation since only limited access to the data might be required. in such a scenario...")

It would have been obvious to one skilled in the art at the time of the invention to combine the MIC system of Wefers with the task-oriented role assignment system of Kahn because it would help to impose proper access control and authorization mechanisms hence, a more efficient method for management and implementation of business processes amongst employees.

Wefers and Kahn disclose all of the limitations described above. The combination of Wefers and Kahn does not disclose the following limitation, but Paulus however, as shown discloses:

- *create a report identifying at least one employee in the set of employees that is simultaneously assigned to business functions that are identified as incompatible as per the at least one business function incompatibility.* (see at least Paragraph 34: "...the IT organization is usually responsible for all information security issues. This includes configuring authentication and authorization solutions according to the business needs defined by the applications. For example, it is often necessary to implement--and prove-- a segregation-of-duties approach within the context of a specific application. In closed systems, a reporting framework that collects information about authorizations, roles, and the data related to users or processes generally provides sufficient auditing capabilities..."; paragraph 57: "...Interface 52 runs autonomous applications under control of the audit warehouse itself that have been established by participating enterprises or the warehouse administrator to run periodic checks or reports and screen data for violations. Thus the output of the internal check interface can be in the form of alerts to the participants as well as reports of periodic checks or spot checks ...")

It would have been obvious to one skilled in the art at the time of the invention to combine the MIC system of Wefers, and the task-oriented role assignment system of Kahn with the audit system of Paulus because it would be an efficient means for reporting compliance with security procedures.

12. With respect to Claim 3,

Wefers, Kahn, and Paulus disclose all of the limitations described above. The combination of Wefers, Kahn, and Paulus does not disclose the following limitation, but Morinville however, as shown discloses:

- *the report further includes an identification of the at least one business function* (see at least Figure 7 and page 3, paragraph 35: "...Analyzing the workflow warehouse with data mining techniques...may identify conditions for which process execution quality departs

from typical or average quality or is incapable of meeting a service level agreement. The user must select a sufficient level of reporting detail to ensure that data directly related to the cause or correlated with the cause of these differences in performance are stored in the audit logs..."; and paragraph 41: "...standard commercial reporting tools can still be used to generate reports..")

It would have been obvious to one skilled in the art at the time of the invention to combine the MIC system of Wefers, the task-oriented role assignment system of Kahn, and the audit system of Paulus with the data mining techniques and reporting tools of Morinville because they can identify that a specific resource fails or is incapable of meeting process requirements under certain conditions which are not otherwise obvious to the observer and may in fact be inter-related with conditions seemingly unrelated to the resource.

13. With respect to Claim 4,

Wefers, Kahn, Paulus, and Morinville disclose all of the limitations described above. The combination of Wefers, Kahn, Paulus, and Morinville does not disclose the following limitations, but Homsy however as shown discloses:

- *the at least one processing component is further configured to run a set of workflow-enabled applications having a set of functions adapted to implement the set of business processes, such that an assignment of business functions to an employee in the set of employees enables the employee to access corresponding functions in the set of functions that implemented said business functions.* (see at least paragraph 80: "...FIG. 3 illustrates an overview of automated workflow system 300 that includes the above described matrix organization search engine 302, which interfaces with an organizational database 304 to service routing requests from user/clients. The user/clients access the workflow system via a network..."; paragraph 128: "...FlowBuilder Objects--FlowBuilder objects 2002 is a database that contains all of the design elements needed to create an application-specific "Notes form". Adding the

FlowBuilder generic subform and footer to an existing form provides the user interface and the technical fields necessary to run web-enabled workflow application 2004. There are two primary FlowBuilder subforms: the "FlowBuilder generic subform" and the "FlowBuilder generic footer..")

It would have been obvious to one skilled in the art at the time of the invention to combine the MIC system of Wefers, the task-oriented role assignment system of Kahn, the audit system of Paulus, and the data mining techniques and reporting tools of Morinville with the Visual Planner Objects, specifically FlowBuilder of Homsy because the the Visual Planner interface allows user to build a matrix-based representation of their organization. The MORSE algorithm used in the Visual Planner allows routing resources to persons with the correct functional roles, hence making a more efficient method for management and implementation of business process and communicating information to employees.

14. With respect to Claim 5,
Wefers, Kahn, Paulus, and Morinville disclose all of the limitations described above.
Morinville further discloses:

- *wherein the storage component is further configured to store a business process library having a plurality of business processes, wherein the set of business processes is a subset of the plurality of business processes of the business process library (see at least Column 3, lines 66, 67 and column 4, lines 1-8: "...defining one or more business processes, a first position within the hierarchical organizational structure associating one or more access/approval rules with a first one of the business processes, wherein the access/approval rules are applicable to a first subset of the roles, and automatically associating the one or more access/approval rules with the first one of the business processes for all positions that are subordinate to the first position within the hierarchical organizational structure and that are associated with the first subset of roles..."; and column 8, lines 34, 35: "...A Library contains information that is linked to role*

hierarchies...”; and column 9, lines 15-20: “...The business processes library houses all of the business processes that are necessary for each role to perform day-to-day business. This information is used to allow employee access to business processes and purchases...”)

It would have been obvious to one skilled in the art at the time of the invention to combine the MIC system of Wefers, the task-oriented role assignment system of Kahn, the audit system of Paulus, the Visual Planner Objects, specifically FlowBuilder (Visual Planner) of Homsy with the data mining techniques and reporting tools of Morinville because this would provide an efficient and accurate means for retrieving business processes and their corresponding roles (for employees).

15. With respect to Claim 6,
- Wefers, Kahn, Paulus, and Morinville disclose all of the limitations described above. Morinville further discloses:
- *the business process library includes a plurality of business function incompatibilities corresponding to at least a portion of the plurality of business processes, each business function incompatibility identifying at least two business functions that should not be simultaneously assigned to a single employee* (see at least column 8, lines 34, 35: “...A Library contains information that is linked to role hierarchies...”; and column 9, lines 15-20: “...The business processes library houses all of the business processes that are necessary for each role to perform day-to-day business. This information is used to allow employee access to business processes and purchases...”; and Figures 3 and 4, and column 6, lines 26-55: “...the organizational structure is a hierarchical data structure of positions reporting to positions. Each position has an associated role which is used to control access to business processes and information... the position of Org 0 in the organizational structure is defined in the system by the following rules: Org 0 cannot be created by the user, ...Org 0 cannot have a superior position;.. Org 0 cannot have people

tracked to it; Org 0 cannot be an approver; ...and Org 0 cannot have more than one directly subordinate position...and lines 57-62: "...positions other than Org 0 are defined by the following rules ... they cannot have more than one superior position ... they cannot have more than one role... they cannot have more than one active user...")

It would have been obvious to one skilled in the art at the time of the invention to combine the MIC system of Wefers, the task-oriented role assignment system of Kahn, the audit system of Paulus, the Visual Planner Objects, specifically FlowBuilder (Visual Planner) of Homsy with the data mining techniques and reporting tools of Morinville because this would provide for communicating information and providing employees access to their respective business processes for various roles.

16. With respect to Claim 7,

Wefers, Kahn, Paulus, and Morinville disclose all of the limitations described above. Morinville further discloses:

- *at least one processing component is further configured to receive a selection from an auditor of a business process from the business process library and, in response to the selection, add the business process to the set of business processes describing the operations of the enterprise and add at least one business function incompatibility to the process compatibility registry.*(referring to Figure 7, page 4, paragraph 47: "...In step 710, a workflow audit log is generated for instances of execution of a defined process. In step 720, the desired process instance execution information is extracted from the audit log. The extracted data is cleaned and transferred into records with pre-determined formats in step 730. This ensures data from different vendor audit logs can be put into a common format for subsequent analysis. The data records are then loaded into the data warehouse in step 740. Steps 720-740 are handled by extract, transfer, and load scripts in one embodiment..."; and paragraph 48: "...In step 750, data mining is applied to the data warehouse data in order to identify patterns across instances of process

executions...”; and paragraph 50: “...In step 760, completion probabilities from the start node and nodes other than the start node can be generated for subsequent instantiations of the process. In step 770, execution of a subsequent instance of the process is modified in response to at least one identified pattern. As discussed above, the process may be dynamically modified by performing any of the steps of modifying the resource assignment, modifying the execution path, redefining the process, changing the activity priority, or changing the resource assignment criteria...”)

17. With respect to Claims 8-11,

Wefers, Kahn, and Paulus disclose all of the limitations described above. Paulus further discloses:

- *an employee in the set of employees is assigned to a new business function wherein the at least one processing component is further configured to create an alert in response to the new business function matching at least one business function incompatibility;*
- *the alert is communicated to an auditor*
- *the alert includes an identification of the employee assigned to the new business function*
- *the alert includes an identification of the at least one business function incompatibility matching the new business function*
- (see at least column 3, lines 1-10: “...The received audit data is sorted and stored by the audit warehouse according to its association with the given business process or subprocess steps of a given business process so that audit data relating to the given business process can be retrieved together to check for compliance with required procedures...”; column 6, lines 8-17: “...the IT organization is usually responsible for all information security issues. This includes configuring authentication and authorization solutions according to the business needs defined by the applications. For example, it is often necessary to implement--and prove--a segregation-of-duties approach within the context of a specific application. In closed systems, a reporting framework that collects

information about authorizations, roles, and the data related to users or processes generally provides sufficient auditing capabilities..."; Figure 5, column 8, lines 2-6: "... The applications themselves must provide the audit warehouse with the necessary information, including document number, type and content, user ID, and role, as well as other data relevant for security checks..."; and Figure 11, column 10, lines 57-60: "... the internal check interface can be in the form of alerts to the participants as well as reports of periodic checks or spot checks for compliance with security procedures..." and claim 18: "...an internal analysis interface for issuing runtime alerts for noncompliant audit data..."; Figures 14-19, column 11 lines 50 -67 thru column 12, lines 1-37: "...FIG. 14 shows the basic components of the format for the XML audit report. Audit report may be for more than one audit environment. Each audit environment is defined by the following attributes, which are in turn defined by parameters shown in FIGS. 15-19, as follows: (1) Applications (See FIGS. 15 and 16); (2) Procedures (or policies--functional checklist) (See FIG. 17); (3) Provisions (or non-functional checklist) (see FIG. 18); and (4) Data (FIG. 19).) The provisions part of the audit XML, as shown in FIG. 18, provides a checklist of non-functional or indirect systems processes in the audit environment. These processes include: (1) operational: training, user manual availability; (2) duty: relevant roles and responsibilities; (3) legal: legal constraints on systems; and (4) financial: financial constraints on systems...Finally, the database part of the audit XML definition is laid out in FIG. 19, and comprises two components: data access and data table. Data access is defined by policies and roles associated with the database that the audit environment is associated with..."

It would have been obvious to one skilled in the art at the time of the invention to combine the MIC system of Wefers, and the task-oriented role assignment system of Kahn, with the audit system of Paulus because this would provide an efficient means for central, tool-supported audits of cross-enterprise business processes.

18. With respect to Claim 12,
Wefers, Kahn, and Paulus, disclose all of the limitations described above. Wefers further discloses:
- *At least one processing component is further configured to prevent the assignment of another new business function to the employee in response to the new business function matching the at least one business function incompatibility. (see at least paragraph 25: "...the flag "role-unique" may prevent a power-user in Step 1 from creating multiple roles..."*

Response to Arguments

9. Applicant's arguments with respect to independent claim1 have been considered but are moot in view of the new ground(s) of rejection.
10. Applicant's arguments with respect to dependent claims 3-12 have been considered but are also moot in view of the new ground(s) of rejection.
11. Applicant's arguments received on May 27, 2008 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filed June 23, 2008.
12. With regard to limitations of applicant's amended claim1 beginning on page 10 of the Remarks, Applicant broadly states that "...claim1 is not rendered obvious by Casati, Morinville, or Paulus, considered individually or in combination..." . In response, all of the limitations which Applicant disputes as missing in the applied references have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Wefers, Kahn, and Paulus based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the

time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action, and in the prior Office Action incorporated herein.

13. With regard to Claims 3-12 on page 14 of the Remarks, Applicant broadly states that “they are from independent claim 1, and are thus believed to be allowable over the cited art for at least a similar rationale...” . In response, all of the limitations which Applicant disputes as missing in the applied reference is fully disclosed or obvious in view of the collective teachings of Wefers, Kahn, Paulus, Morinville, and Homsy and base on the logic of one ordinarily skilled in the art. Detailed explanations are given in the preceding sections of the present Office Action.

14. In addition, in response to Applicant’s argument that the reference fails to show certain features of Applicant’s invention, it is noted that the features upon which applicant relies:

- i. “...a storage component configured to store...” appears to constitute new matter.
- ii. “...create a report identifying at least one employee ‘in the set of employees’ that is simultaneously assigned to business functions that are identified as incompatible as per the at least one business function incompatibility...” appears to constitute new matter.
- iii. “...simultaneously assigned...” appears to constitute new matter.
- iv. “...in the set of employees...” appears to constitute new matter.

are not recited in the original specification or originally filed claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner hereby identifies “...a storage component configured to store...” as identified in claim 1; “...create a report identifying at least one employee ‘in the set of employees’ that is

simultaneously assigned to business functions that are identified as incompatible as per the at least one business function incompatibility...” as recited in Claim 1; “...simultaneously assigned...” as recited in claim 1; “...in the set of employees...” as recited in claims 1 and 4 as new matter since the specification as originally written does not support the newly added claim and/or claim language.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kimberly L. Evans** whose telephone number is **571.270.3929**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **John Weiss** can be reached at **571.272.6812**.

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17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov> >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free). Any response to this action should be mailed to: **Commissioner of Patents and Trademarks**, P.O. Box 1450, Alexandria, VA 22313-1450 or faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**: Randolph Building 401 Dulany Street, Alexandria, VA 22314.

/KIMBERLY EVANS/Examiner, Art Unit 3629

October 1, 2008

/John G. Weiss/

Supervisory Patent Examiner, Art Unit 3629